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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,493	10/16/2003	Motonaga Gomi	1619.1025	5367

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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/685,493

Applicant(s)

GOMI ET AL.

Examiner

Doug Hutton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20051016.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because the entire specification is replete with **idiomatic errors in the English language**. The present application claims priority to Japanese Patent Application No. 2002-305028 and appears to be a poorly-worded translation of the Japanese application.

A substitute specification in **proper idiomatic English** and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

The disclosure is also objected to because the entire specification is replete with terminology which is ***different*** from that which is generally accepted in the art to which this invention pertains and does not conform to United States patent practice. For example, the phrase "Web viewer" in Paragraph 0002 probably refers to a web browser. Other examples include: the "absolute description" of the linked files in Paragraph 0003, which possibly refers to the URLs of the linked files; and the "description" of the linked files in Paragraph 0004, which possibly refers to the HTML code within each linked file. These phrases are not typically used in United States patent practice to describe these elements of web browsing and web pages.

Finally, the disclosure is objected to because the translation of the Japanese patent application is **inaccurate**. For example, text in Paragraph 0003 reads: "Printed navigation icons such as a previous-page button icon, a next-page button icon, a top-

page button icon, and navigation banner, which are necessary in browsing operation but not necessary in printed material, **reduce** (emphasis added) density of information in printing page unit.” This statement is not accurate in that, if the navigation icons of a web page are printed in a hard copy printout of the web page, then the “density of information” in the printed page is **increased**. This is but one example of the multitude of errors made in translating the Japanese patent application.

To obviate this objection, Applicant should go through the entire specification – word-by-word, sentence-by-sentence, paragraph-by-paragraph – and rewrite the entire specification so that it: 1) reads easily for, and is easily understood by, a person whose native language is English; 2) consistently uses terminology – **used in the United States** – that is generally accepted in the art; 3) conforms to United States patent practice; and 4) accurately describes Applicant’s invention.

Additionally, the disclosure is objected to because the entire specification is replete with instances where a **single** element of the present invention is identified using a **plurality** of terms, whereby such use makes it unclear as to which element is being discussed in that portion of the text. For example, the “HTML file” in Paragraph 0002 is called a “main file” in Paragraph 0003. Applicant must amend the Specification so that the terms used to identify the elements of the present invention are used in a **consistent** manner.

For Applicant's convenience, the examiner submits the following proposed amendment for that portion of the Specification entitled "BACKGROUND OF THE INVENTION" as an example of a properly-worded correction that will obviate the objections. Applicant should amend the remainder of the Specification in a like manner.

BACKGROUND OF THE INVENTION

1. Field of the Invention

[0001] This invention relates to a ~~technology for printing processing in which an electronic~~ a markup language document. ~~(Web document) described in a markup language premised on viewing by a Web viewer~~ The document is downloaded via a network, such as the Internet, and printed ~~onto sheet material~~ as a hard copy having a proper style as a booklet or a book.

2. Description of the Related Art

[0002] To download and print an electronic document ~~stored on the network needs hardware requirements to be enable~~ via the Internet, a continuous connection or dialup connection to the Internet is required. When the electronic document is stored as an HTML file ~~(HTML file) described in HTML (HyperText Markup Language)~~, ~~one Web page of the electronic document displayed on the screen by the~~ in a Web viewer browser may include some links to other files. Accordingly, the printing processing of the displayed page document requires ~~[[a]] downloading [[of]] the linked files in the main HTML file after the downloading the main file of the displayed page.~~

[0003] ~~In case~~ If the linked files ~~forming in~~ the electronic document are temporarily stored in a local area of a computer ~~before printing operation~~, a user needs to modify the ~~absolute description~~ URLs of the links in the ~~main file~~ document to the location of ~~storing the~~ locally-stored linked files ~~in the local area~~. ~~Further, the~~ The direct printing of the electronic document displayed by the Web viewer browser causes some problems~~[[:]~~, such as ~~Printed~~ navigation icons ~~such as a previous page button icon, a next page button icon, a top page button icon, and navigation banner, which are necessary in browsing operation but are not necessary in printed material, reduce density of information in printing~~ crowding the printed page unit.

[0004] In order to shorten the time of printing an electronic document described in HTML, Japanese Unexamined Patent Application Publication No. 11-25146 (Related art 1) describes ~~the a~~ method in which a system downloads the linked files forming the Web page, automatically embeds the description HTML code of the each linked file (the linked page) at the point of the link anchor ~~of the main file~~ in the Web page (the main page), and prints a hard copy of the new edited file Web page. According to the method disclosed in ~~the related~~ Related art 1, the method may solve ~~such an~~ the inconvenience ~~on the operation of downloading the linked page files again and manually correcting the description~~ HTML code of the linked files in the ~~original page by manual~~ Web page. The conventional method may also reduce ~~[[a]]~~ the blank space of each printed page at to some degree ~~in printed sheets~~. However, in the method disclosed in ~~the related~~ Related art 1, the description HTML code of the each linked page file is simply inserted into the position in the original main HTML file Web page and the processed ~~main page~~

Web page is simply and continuously printed. Therefore, according to the method disclosed in the related Related art 1, it may be difficult that a printing the printing processing such of the Web pages does not supply a printed material having result in the proper style of a booklet or book.

Claim Objections

Claims 1-16 are objected to because the claims comprise idiomatic errors in the English language and because the claims are worded confusingly. Applicant must amend the claims to correct the idiomatic errors in the claims and the confusingly worded portions of the claims.

To obviate these objections, Applicant should go through the each claim – word-by-word, element-by-element, section-by-section – and rewrite the each claim so that every claim reads easily for, and is easily understood by, a person whose native language is English.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-16:

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For example, in Claim 1, the passage *"file analyzing and converting means for analyzing the description of the document file based on the analysis defining information, for deleting information unnecessary for printing of the document from the document file, for analyzing a document structure of the electronic document, for dividing the document file on item unit generating the document structure in accordance with the analyzed document structure, and for generating a converted files; and"* (see Lines 10-15) has several problems that lead to questions concerning the passage.

These questions include: 1) Does this passage intend to claim a **"means for"** deleting, a **"means for"** dividing and a **"means for"** generating? 2) Does the phrase *"analyzing the **description** of the document file"* mentioned in the passage involve the markup language document mentioned in Line 1? 3) What does *"dividing the document file on item unit generating the document structure in accordance with the analyzed document structure"* (Lines 13-15) mean?

Generally speaking, Claim 1 needs to be amended so that the subject matter recited in the claim is better organized and more clearly recited. In order to do this,

Applicant should determine **what** the software **does**, (i.e., the functions performed by the software), determine the **relationships** of the software functions, and recite the functions performed by the software in a way that **comprehensively defines the invention using idiomatic English**. For Claim 1, Applicant may want to begin each new paragraph of the claim in the following manner: *means for [insert a function performed by the software]*.

As indicated in the above discussion, the entire disclosure (i.e., the Specification and the Claims) of the present invention is very poorly-worded. Thus, at this time, the examiner deems it impractical to give a complete action on the merits for this application. However, the examiner has performed a search to locate, what he believes to be, the most relevant prior art. Applicant is encouraged to look at the prior art listed on the attached Form PTO-892 and amend the claims so as to distinguish the present invention from the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Jang et al., U.S. Patent No. 6,728,403; DeRose et al., U.S. Patent No. 6,546,406; Day et al., U.S. Patent Application Publication No. US 2004/0015782; Olson-Williams et al., U.S. Patent No. 6,185,588; Bates et al., U.S. Patent No. 6,917,436; Hsu et al., U.S. Patent Application Publication No. US

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2002/0083096; Hsu et al., U.S. Patent No. 6,377,956; and Nakamura et al., U.S. Patent No. 6,178,433.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
January 1, 2006



**DOUG HUTTON
PRIMARY EXAMINER
TECH CENTER 2100**